

## **REMARKS**

The Final Office Action mailed November 1, 2007, has been received and reviewed. Each of claims 1–55 stands rejected. Claims 1 and 17 have been amended herein. Accordingly, claims 1–55 remain pending. Care has been exercised to introduce no new subject matter. Reconsideration of the above-identified application in view of the above amendments and the following remarks is respectfully requested.

### **Rejections based on 35 U.S.C. § 103**

#### **A. Applicable Authority**

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). *See also KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval) MPEP § 2142. “[R]ejections on obviousness cannot be sustained with mere conclusory statements.” *Id.* Thus, in order to establish a *prima facie* case of obviousness the scope and content of the prior art must be

explained, the level of ordinary skill in the prior art ascertained, and the differences between the claimed invention and prior art references explained. Further, “a clear articulation of the reason(s) why the claimed invention would have been obvious” is required. MPEP § 2143. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. *Id.*

**B. Rejections Based Upon U.S. Publication No. 2004/0148434 to Matsubara in view of U.S. Publication No. 2003/0028610 to Pearson and further in view of U.S. Publication No. 2003/0212710 to Guy**

Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2004/0148434 to Matsubara (hereafter the “Matsubara reference”) in view of U.S. Publication No. 2003/0028610 to Pearson (hereafter the “Pearson reference”) and further in view of U.S. Publication No. 2003/0212710 to Guy (hereafter the “Guy reference”). As the differences between the claimed invention and the prior art references are significant and the Office’s rationale for obviousness is merely conclusory, Applicants respectfully traverse the rejection, as hereinafter set forth.

Claim 1 recites a method of designating items as available to share in a computer system between a sharer and a sharee. The method includes executing on the sharer’s computer a query comprising a scope and a criteria, wherein the scope and the criteria are submitted by the user of the sharer’s computer. The method also includes creating on the sharer’s computer a list with a plurality of referenced items based on the results of said query. The method further includes defining the contents of one or more virtual folders on the sharer’s computer based on the list, the one or more virtual folders configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying and pasting. The method also includes making the contents of the one or more virtual folders available for sharing with the

sharee and sharing at least a portion of the one or more virtual folders with a sharee such that the sharee is provided with access to the referenced items from the sharee's computer.

In contrast, the Matsubara reference describes a peer-to-peer interface device. The peer-to-peer interface device allows a web browser to access files and information on a peer-to-peer network without downloading peer-to-peer network software or becoming a node in the peer-to-peer network. *See Matsubara Reference Abstract*. The gateway allows users to access files on the peer-to-peer network and peer-to-peer network users to access files from the gateway. *See Matsubara Reference [0063]*.

The Pearson reference describes a peer-to-peer file sharing system and method. The Pearson reference describes a process by which a first host computer searches for a file on a second computer. The search query is suggested by the user of the searching computer which sends a request to the second computer. The second computer conducts a search of its available files and responds with a list of files that match the search criteria submitted by the first computer. *See Pearson Reference [0030]*.

The Guy reference describes a system for tracking activity and delivery of advertising over a file network such as a peer-to-peer network. *See Guy Reference Abstract*. The Guy reference describes tracking the files that are transferred on a peer-to-peer network to determine which file transfers are the most popular. *See Guy reference [0018]*.

There are several differences between claim 1 and the combination of references cited by the Office. For example, the combination of references does not teach "executing on the sharer's compute a query comprising a scope and a criteria, wherein the scope and the criteria are submitted by the user of the sharer's computer" as recited in claim 1. The Matsubara reference describes the requesting computer (the sharee) sending a request for particular files to the sharer

computer. *See* Matsubara Reference [0055]. The Office correctly notes that the Matsubara reference does not describe a query comprising a scope and a criteria that is used to generate a list with a plurality of items based on the results of said query. *See* Office Action dated November 1, 2007, p3. As described previously, the Pearson reference describes submitting search criteria on a sharee's computer (referred to as the querying computer in the Pearson reference) that is in turn sent to the sharer's computer (queried computer). The sharer computer then conducts a search and returns a list of items that satisfy the search criteria. *See* Pearson reference [0030]. Thus, "the scope and the criteria" are not submitted by the user of the sharer's computer but by the user of the sharee's computer. As stated previously, the Guy reference describes tracking files shared within a P2P network. Searching for files on a sharer's computer is not described in the Guy reference. Accordingly, the combination of references does not describe "executing on the sharer's compute a query comprising a scope and a criteria, wherein the scope and the criteria are submitted by the user of the sharer's computer."

A second difference between claim 1 and the combination of references cited by the Office is that the combination of references do not use search results to define the scope of files available for sharing. Claim 1 describes "defining the contents of one or more virtual folders on the sharer's computer based on the list [produced as a result of the query]" and "making the contents of the one or more virtual folders available for sharing with the sharee." The Matsubara reference describes designating files for sharing by uploading a copy to the P2P gateway. *See* Matsubara Reference [0063]. The uploaded file is not designated for sharing because it meets search criteria. The Pearson reference describes a search of files that have previously been made available for sharing through a separate process that is not described. *See* Pearson reference [0030]. The search in the Pearson reference does not result in designating files

for sharing. Similarly, the Guy reference does not describe how files are made available for sharing. Thus, the combination of references describes designating files by uploading them to a P2P gateway. This is significantly different than making files that meet search criteria available for sharing.

Furthermore, the Office has not provided a satisfactory explanation as to why a person having ordinary skill in the art would combine or modify these references to develop a method of making files available for sharing. None of the references focus on designating items on a computer for sharing with other users on the peer-to-peer network or otherwise. A person having ordinary skill in the art would receive little or no guidance to help develop the method described in claim 1 from the combination of references. The only useful information gleaned from the combination of references is the very general proposition that files can be shared between computers over a network and that files may be designated for sharing. The combination of references does not provide guidance that would lead a person having ordinary skill in the art to teachings of claim 1.

Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case because the differences between claim 1 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claim 1.

Claims 2-9, 43-44, and 49 depend, either directly or indirectly, from allowable claim 1 and contain further limitations that are not described by the combination of references. For example, claims 2-4 describe adding and subtracting items from the list of available items that was originally generated as a result of the query. The combinations of references do not

describe modify the content of query results by adding items to the list or subtracting items from the list. Claims 5-9 describe updating the contents of the virtual folder as new items that match the search criteria are added to the system or characteristics of existing items change to match, or cease to match, the search criteria. Accordingly, claims 2-9, 43-44, and 49 are allowable by virtue of their dependency from allowable claim 1 and further novel features described by the claims. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 2-9, 43-44, and 49.

Claim 10 recites a method for sharing items on a computer system including receiving permission to access a list on the sharer's computer with referenced items. The referenced items are based on the results of a query executed on the sharer's computer, and the list defines the contents of one or more virtual folders on the sharer's computer. The method also includes, in response to receiving the permission to access the list, accessing the list and the referenced items that have been determined by the sharer's computer to be shared in a sharing format, the sharing format being one of a static list and a dynamic list. The one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting.

The Matsubara reference, Pearson reference, and Guy reference have been described previously with reference to claim 1. As with claim 1, there are several differences between claim 10 and the combination of references cited by the Office. For example, the combination of references does not teach "receiving permission to access a list on the sharer's computer" where the list is "based on the results of a query executed on the sharer's computer" as recited in claim 10. As described previously, the Matsubara reference describes designating files for sharing by uploading a copy to the P2P gateway. *See* Matsubara Reference [0063]. The

uploaded file is not designated for sharing because it meets search criteria. The Pearson reference describes a search of files that have previously been made available for sharing through a separate process that is not described. *See* Pearson reference [0030]. The search in the Pearson reference does not result in designating files for sharing. Similarly, the Guy reference does not describe how files are made available for sharing. Thus, the combination of references describes designating files by uploading them. This is significantly different than making files that meet search criteria available for sharing. This difference represents a large gap between the teaching of the cited references and claim 10.

Furthermore, for reasons substantially similar to those given with reference to claim 1, the Office has not provided a satisfactory explanation as to why a person having ordinary skill in the art would combine or modify these references to develop a method of making certain files available for sharing. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 10 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 11-16, 45-46 and 50 depend, either directly or indirectly, from allowable claim 10. Thus, claims 11-16, 45-46 and 50 are allowable at least by virtue of their dependency from allowable claim 10. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 11-16, 45-46 and 50.

Claim 17, as currently amended, recites one or more computer-readable media for enabling a computer-program segment to communicate with one or more other computer-program segments. The media including a set of computer-usable instructions that cause a request to provide access to a set of items to be communicated to one or more other computer-

program segments capable of executing said request, wherein the set of items include results of a query executed on the sharer's computer, and wherein the results are included in one or more virtual folders on the sharer's computer. The one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting, said referenced items are determined by the sharer's computer to be shared in a sharing format, the sharing format being one of a static list format and a dynamic list format.

The Matsubara reference, Pearson reference, and Guy reference have been described previously with reference to claim 1. As with claims 1 and 10, there are several differences between claim 17 and the combination of references cited by the Office. For example, the combination of references does not teach a request for access to a set of items that "include results of a query executed on the sharer's computer" as recited in claim 17. As described previously, the Matsubara reference describes designating files for sharing by uploading a copy to the P2P gateway. *See* Matsubara Reference [0063]. The uploaded file is not designated for sharing because it meets search criteria. The Pearson reference describes a search of files that have previously been made available for sharing through a separate process that is not described. *See* Pearson reference [0030]. The search in the Pearson reference does not result in designating files for sharing. Similarly, the Guy reference does not describe how files are made available for sharing. Thus, the combination of references describes designating files by uploading them to a P2P gateway. This is significantly different than making results of a query executed on the sharer's computer available for sharing. This difference represents a large gap between the teaching of the cited references and claim 17.

Furthermore, for reasons substantially similar to those given with reference to claim 1, the Office has not provided a satisfactory explanation as to why a person having



ordinary skill in the art would combine or modify these references to develop a method of making certain files available for sharing. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 17 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 18-23 and 51 depend, either directly or indirectly, from allowable claim 17. Thus, claims 18-23 and 51 are allowable at least by virtue of their dependency from allowable claim 17. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 18-23 and 51.

Claim 24 recites, a method of communicating between a sharer of a list and a sharee including receiving from the sharee a call for accessing on a computer of the sharer items that are referenced on the list, wherein the list is based on the results of a query executed on the sharer's computer referenced in one or more virtual folders on the sharer's computer, and stored on the sharer's computer, and determined by the sharer's computer to be shared in a sharing format, wherein the sharing format is one of a static list format and a dynamic list format. The method further includes, responsive to authorization received from the sharer, providing the sharee access to the items in the determined sharing format. The one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting.

The Matsubara reference, Pearson reference, and Guy reference have been described previously with reference to claim 1. There are several differences between claim 24 and the combination of references cited by the Office. For example, the combination of references does not teach "receiving from the sharee a call for accessing on a computer of the

sharer items that are referenced on the list, wherein the list is based on the results of a query executed on the sharer's computer" as recited in claim 24. As described previously, the Matsubara reference describes designating files for sharing by uploading a copy to the P2P gateway. *See* Matsubara Reference [0063]. The uploaded file is not designated for sharing because it meets search criteria. The Pearson reference describes a search of files that have previously been made available for sharing through a separate process that is not described. *See* Pearson reference [0030]. The search in the Pearson reference does not result in designating files for sharing. Similarly, the Guy reference does not describe how files are designated for sharing. Thus, the combination of references describes designating files by uploading them. This is significantly different than "receiving from the sharee a call for accessing on a computer of the sharer items that are referenced on the list, wherein the list is based on the results of a query executed on the sharer's computer." This difference represents a large gap between the teaching of the cited references and claim 24.

Furthermore, for reasons substantially similar to those given with reference to claim 1, the Office has not provided a satisfactory explanation as to why a person having ordinary skill in the art would combine or modify these references to develop a method of making certain files available for sharing. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 24 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 25-30, 47-48 and 52-53 depend, either directly or indirectly, from allowable claim 24. Thus, claims 25-30, 47-48 and 52-53 are allowable at least by virtue of their dependency from allowable claim 24.

Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 11-16, 45-46 and 50.

Claim 31 recites one or more computer-readable media for enabling a sharer to share a set of items that are referenced on a list with a sharee comprising a set of computer-usable instructions that allow the sharee to access the items directly through the sharer's computer. The set of item referenced on the list are based on the results of a query executed on the sharer's computer, and wherein the list comprises an order of the items referenced on the list, the list is referenced in one or more virtual folders on the sharer's computer. The list is determined by the sharer's computer to be shared to the sharee in a sharing format, the sharing format being one of a static list format and a dynamic list format, and the one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting.

The Matsubara reference, Pearson reference, and Guy reference have been described previously with reference to claim 1. There are several differences between claim 31 and the combination of references cited by the Office. For example, the combination of references does not teach "one or more computer-readable media for enabling a sharer to share a set of items that are referenced on a list with a sharee . . . wherein, the set of item referenced on the list are based on the results of a query executed on the sharer's computer" as recited in claim 31. As described previously, the Matsubara reference describes designating files for sharing by uploading a copy to the P2P gateway. *See* Matsubara Reference [0063]. The uploaded file is not designated for sharing because it meets search criteria. The Pearson reference describes a search of files that have previously been made available for sharing through a separate process that is not described. *See* Pearson reference [0030]. The search in the Pearson reference does not result

in designating files for sharing. Similarly, the Guy reference does not describe how files are designated for sharing. Thus, the combination of references describes designating files by uploading them to a P2P gateway. This is significantly different than making results of a query executed on the sharer's computer available for sharing. This difference represents a large gap between the teaching of the cited references and claim 31.

Furthermore, for reasons substantially similar to those given with reference to claim 1, the Office has not provided a satisfactory explanation as to why a person having ordinary skill in the art would combine or modify these references to develop a method of making certain files available for sharing. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 31 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 32-35 and 54 depend, either directly or indirectly, from allowable claim 31. Thus, claims 32-35 and 54 are allowable at least by virtue of their dependency from allowable claim 31. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 32-35 and 54.

Claim 36 recites, a method for sharing items in a computer system between a sharer and a sharee including executing on the sharer's computer a query comprising a scope and a criteria. The method also includes creating on the sharer's computer one or more virtual folders with a plurality of referenced items based on the results of said query and determining the sharing format of the list to be shared to the sharee, wherein the sharing format is one of a static list and a dynamic list. The method further includes sharing the one or more virtual folders with a sharee such that the sharee is provided with access to the referenced items from the sharer's

computer in the determined sharing format. The one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting.

The Matsubara reference, Pearson reference, and Guy reference have been described previously with reference to claim 1. There are several differences between claim 36 and the combination of references cited by the Office. For example, the combination of references does not teach “executing on the sharer’s computer a query comprising a scope and a criteria . . . creating on the sharer’s computer one or more virtual folders with a plurality of referenced items based on the results of said query and . . . sharing the one or more virtual folders with a sharee such that the sharee is provided with access to the referenced items from the sharer’s computer” as recited in claim 36. As described previously, the Matsubara reference describes designating files for sharing by uploading a copy to the P2P gateway. *See* Matsubara Reference [0063]. The uploaded file is not designated for sharing because it meets search criteria. The Pearson reference describes a search of files that have previously been made available for sharing through a separate process that is not described. *See* Pearson reference [0030]. The search in the Pearson reference does not result in designating files for sharing. Similarly, the Guy reference does not describe how files are made available for sharing. Thus, the combination of references describes designating files by uploading them. This is significantly different than making results of a query executed on the sharer’s computer available for sharing. This difference represents a large gap between the teaching of the cited references and claim 36.

Furthermore, for reasons substantially similar to those given with reference to claim 1, the Office has not provided a satisfactory explanation as to why a person having

ordinary skill in the art would combine or modify these references to develop a method of making certain files available for sharing. Thus, Applicants respectfully suggest that the office has not carried its burden of establishing a *prima facie* case of obviousness because the differences between claim 36 and the cited references are large and the Office has not provided a rational underpinning to support the legal conclusion of obviousness. Claims 37-42 and 55 depend, either directly or indirectly, from allowable claim 36. Thus, claims 37-42 and 55 are allowable at least by virtue of their dependency from allowable claim 36. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C § 103(a) rejection of claims 37-42 and 55.

### CONCLUSION

For at least the reasons stated above, claims 1-55 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or twilhelm@shb.com (such communication via email is herein expressly granted) – to resolve the same.

The appropriate fees for an RCE and a three-month extension of time are submitted herewith. It is believed that no additional fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112, referencing Attorney Docket No. MFCP.139945.

Respectfully submitted,

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